

REMARKS

Claims 1 – 36 remain in the application and stand rejected. Claims 1, 5 – 9, 18, 20, 22-23, 26, 29, 33 and 34 are amended herein. Although this Response is being timely filed, the Commissioner is hereby authorized to charge any fees that may be required for this paper or credit any overpayment to Deposit Account No. 19-2179.

Claims 5 – 9, 33 and 34 are objected to for formal reasons. Claims 18 and 23 are rejected as being indefinite. Responsive thereto, claims 5 – 9, 18, 23, 33 and 34 are amended herein. Claims 5 – 9, 18, 23, 33 and 34 as amended are believed to be definite and no new matter has been added. Reconsideration and withdrawal of the objection to claims 5 – 9, 33 and 34 and rejection of claims 18 and 23 under 35 U.S.C. §112 is respectfully requested.

Claims 1 – 19, 25 – 32 and 36 are rejected under 35 USC §102(b) as being unpatentable over published U.S. Patent Application No. 2002/0085516 to Bridgelall. Thus, since claim 20 is not rejected over Bridgelall, it is deemed acknowledged that Bridgelall does not teach on-demand hand-overs. Amended claim 1 recites “monitoring said first call device for on-demand hand-over overrides;” and amended claim 29 recites “an on-demand hand-over override selectively overriding said detector circuit,” which is neither taught nor suggested by Bridgelall. Accordingly, claims 1 – 36, as amended, are patentable over Bridgelall. Reconsideration and withdrawal of the rejection of claims 1 – 19, 25 – 32 and 36 under 35 U.S.C. §102(b) over Bridgelall is respectfully requested.

Claims 1 – 15, 19 – 25, 27 – 32, 35 and 36 are rejected under 35 USC §102(b) as being unpatentable over U.S. Patent No. 6,327,470 to Ostling. Claims 33 and 34 are rejected under 35 USC §103(a) as being unpatentable over Ostling in view of Official Notice. In specifically rejecting claim 20, it is asserted that Ostling teaches on-demand hand-overs at col. 4, line 65 – col. 5, line 8. It is respectfully submitted that, this is not what Ostling teaches, at least within the meaning of the present invention.

Ostling teaches a dual mode mobile station that includes a handover application 302 managing the handovers. *See, e.g.*, col. 3, line 54 – col. 4, line 31. Ostling col. 4, line 65 – col. 5, line 8 recites that

as shown in FIG. 4, the dual mode phone 400 can have a ‘handover’ button 410, which the subscriber presses to manually initiate the handover. In this embodiment, the dual mode phone 400 can send a signal strength warning tone to the subscriber, indicating that the subscriber is leaving the fixed mode coverage area 308, which would **allow the subscriber** to either press the ‘handover’ button 410 and initiate the call transfer, return to the fixed mode coverage area 308, or disconnect the call before the subscriber leaves the fixed mode coverage area 308.

(emphasis added) Providing a warning tone at the threshold and allowing someone to initiate a handover is quite different than performing hand-over on-demand prior to reaching the hand-over threshold as claim 20 recites. Therefore, Ostling does not teach or suggest the present invention as recited in claim 20, both as filed and as amended.

Moreover, claim 29 recites that a mobility server “establishes a connection to said target device upon acceptance of said call by said target device.” The Ostling dual mode mobile station neither includes, describes, or suggests a mobility server establishing the connection.

Furthermore, as noted hereinabove, amended claim 1 recites “monitoring said first call device for on-demand hand-over overrides;” and amended claim 29 recites “an on-demand hand-over override selectively overriding said detector circuit,” neither of which is taught or suggested by Ostling. Accordingly, claims 1 and 29, as amended, are patentable over Ostling.

Reconsideration and withdrawal of the rejection of claims 1 and 29 under 35 U.S.C. §102(b) is respectfully requested.

Furthermore, since dependent claims include all of the differences with the prior art as the claims from which they depend, claims 2 – 15, 19 – 25, 27, 28, 30 – 32, 35 and 36, and claims 33 and 34 as well, are patentable over Ostling. Reconsideration and withdrawal of the rejection of claims 2 – 15, 19 – 25, 27 28, and 30 – 36 under 35 U.S.C. §§102(b) and 103(a) is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth

above, the applicant respectfully requests that the Examiner, reconsider and withdraw the objection to claims 5 – 9, 33 and 34, reconsider and withdraw the rejection of claims 1 – 36 under 35 U.S.C. §§102(b), 103(a) and 112 and allow the application to issue.

Should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the telephone number listed below for a telephonic or personal interview to discuss any other changes.

Respectfully submitted,

January 12, 2006

(Date)

Siemens Corporation
Intellectual Property Department
170 Wood Avenue South
Iselin, New Jersey 08830
(732) 321-3130

Francis Montgomery

Francis G. Montgomery

Reg. No. 41,202